

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:	:	Before the Examiner:
McKnight et al.	:	Bashore, William L.
	:	
Serial No.: 09/489,793	:	Group Art Unit: 2176
	:	
Filing Date: January 24, 2000	:	
	:	
Title: SYSTEM AND METHOD	:	IBM Corporation
FOR CAPTURING DOCUMENT	:	Dept. T81/Bldg. 503
STYLE BY EXAMPLE	:	P.O. Box 12195
	:	3039 Cornwallis Road
	:	Research Triangle Park, NC 27709
	:	

REPLY BRIEF UNDER 37 C.F.R. §41.41

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This Reply Brief is being submitted in response to the Examiner's Answer dated September 5, 2007, with a two-month statutory period for response set to expire on November 5, 2007.

I. RESPONSE TO EXAMINER'S ARGUMENTS:

- A. Response to Examiner's assertion that claims 16-36 are properly rejected under 35 U.S.C. §101, as discussed on pages 3-4 of Examiner's Answer.

The Examiner rejects claims 16-36 under 35 U.S.C. §101 as being directed to non-statutory subject matter. Examiner's Answer, page 2. In particular, the Examiner asserts that independent claims 16, 22, 23, 24, 26, 27 and 35 do not produce a useful, concrete and tangible result. Examiner's Answer, pages 2-3. Appellants respectfully traverse.

The Congressional intent is that any new and useful process, machine, manufacture or composition of matter under the sun that is made by man is the proper subject matter of a patent. M.P.E.P. §2106. The subject matter courts have found to be outside the four statutory categories is limited to subject matter that is not a practical application or use of an idea, a law of nature or a natural phenomenon. *See, e.g., Rubber-Tip Pencil Co. v. Howard*, 87 U.S. (20 Wall.) 498, 507 (1874); M.P.E.P. §2106. Claims 16 and 27 are directed to a computer program product embodied in a computer readable medium, which is not outside the four statutory categories, for generating an output document in a user preferred style. Further, claims 22 and 23 are directed to a computer program product embodied in a computer readable medium, which is not outside the four statutory categories, for generating an output document. Additionally, claim 24 is directed to a computer program product embodied in a computer readable medium, which is not outside the four statutory categories, for formatting a document. Furthermore, claim 26 is directed to a computer program product embodied in a computer readable medium, which is not outside the four statutory categories, for formatting documents. Additionally, claim 35 is directed to a computer program product embodied in a computer readable medium, which is not outside the four statutory categories, for generating an output document with indentation of document components in a user preferred style.

Appellants respectfully contend that the claimed inventions in claims 16-36 satisfy the test for statutory subject matter recited in *In re Alappat*, and repeated in

State Street Bank & Trust Co. v. Signature Financial Group, and *AT&T Corp. v. Excel Communications, Inc.* *In re Alappat*, 33 F.3d 1526, 31 U.S.P.Q.2d 1545 (Fed. Cir. 1994); *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d 1368, 47 U.S.P.Q.2d 1596 (Fed. Cir. 1998); *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1526, 50 U.S.P.Q.2d 1547 (Fed. Cir. 1999). The claimed inventions produce a useful, concrete and tangible result in, *inter alia*, generating an output document, generating an output document in a user preferred style, formatting a document, generating an output document with indentation of document components in a user preferred style.

The essential inquiry under *In re Alappat* is to determine whether the claimed subject matter as a whole is directed to a disembodied mathematical concept representing nothing more than a "law of nature" or an "abstract idea" or if, in contrast, the mathematical concept has been reduced to some practical application rendering it useful. *AT&T Corp.*, 172 F.2d at 1357, 50 U.S.P.Q.2d at 1451 (citing *In re Alappat*, 33 F.3d at 1543, 31 U.S.P.Q.2d at 1556-57). Moreover, in making the determination whether the claimed subject matter as a whole is a disembodied mathematical concept or if the concept has been reduced to some practical application rendering it useful, the claims must be construed in the light of the Specification. *See, AT&T Corp.*, 172 F.3d at 1357, 50 U.S.P.Q.2d at 1451 (stating that more than an abstract idea was claimed in *In re Alappat* because the "claimed invention as whole was directed toward forming a specific machine that produced the useful, concrete and tangible result of a *smooth wave form display*") (emphasis supplied). The single claim at issue in *In re Alappat* was directed to a rasterizer and recited elements in means plus function form. *In re Alappat*, 33 F.3d at 1540, 31 U.S.P.Q.2d at 1555. Additionally, none of the limitations recited in the claim at issue expressly claimed a "smooth wave form display". Indeed, the concrete, useful and tangible result relied upon in *In re Alappat*, namely, a smooth uniform display, appears in the background of the invention. *Kuriappan P. Alappat, et al.*, U.S. Patent No. 5,440,676 (col. 1, lines 9-10).

Likewise, in *AT&T Corp.*, the useful, nonabstract result relied upon in holding that the claimed invention was directed to statutory subject matter was that the PIC indicator therein held information about the call recipients PIC, which facilitated differential billing of long-distance calls made by a subscriber. *AT&T Corp.*, 172 F.3d 1358, 50 U.S.P.Q.2d at 1452. However, the claim at issue in *AT&T Corp.* was directed to a method including the steps of generating a message record for an interexchange call, and including in the message record a PIC indicator having a value which is a function of whether or not the interexchange carrier associated with the terminating subscriber is a predetermined one of the interexchange carriers. *AT&T Corp.*, 172 F.3d at 1354, 50 U.S.P.Q.2d at 1449. Again, there was no express or explicit claim limitation directed to the useful, concrete, and tangible result relied upon in determining that the aforesaid claim was directed to statutory subject matter. See, *Id.* The relied upon PIC indicator that facilitates differential billing of long-distance calls appears, *inter alia*, in the summary of the invention. *Gerard P. Doherty, et al.*, U.S. Patent No. 5,333,184, col. 1, line 66 through col. 2, line 3.

Likewise, in *State Street Bank & Trust v. Signature Financial Group*, a useful and concrete and tangible result not expressed in an explicit limitation in the claim at issue was relied upon in holding that the claim was directed to statutory subject matter. See, *State Street Bank*, 149 F.3d at 1373, 47 U.S.P.Q.2d at 1601 (holding that the transformation of data by the claimed data processing system produced a useful, concrete and tangible result, namely a final share price momentarily fixed for recording and reporting purposes). The claimed invention recited no limitation directed to either a final share price or means for momentarily fixing the final share price for recording and reporting purposes. See, *State Street Bank*, 149 F.3d at 1371, 47 U.S.P.Q.2d at 1599. Indeed, the relied upon useful, concrete and tangible result in *State Street Bank*, namely a final share price momentarily fixed, is not explicitly recited in the *State Street Bank* patent, but is effectively a distillation of the Summary of the Invention. See, *R. Todd Boes*, U.S. Patent No. 5,193,056, col. 4, lines 36-61. Thus, it is beyond peradventure that when judging the claimed subject matter as a

whole to determine patentability under 35 U.S.C. § 101, the claims must be construed in the light of the specification.

In short, the question whether a claim encompasses statutory subject matter focuses on the essential characteristics of the subject matter, in particular its utility. *State Street Bank*, 149 F.3d at 1375, 47 U.S.P.Q.2d at 1602.

The Examiner contends that the cited claims do not produce a useful, concrete and tangible result. However, claims 16-36 clearly do produce a useful, concrete and tangible result when construed in light of the specification. Appellants' specification discusses that it would be advantageous to provide an improved system and method for formatting output documents in a style preferred by a user. Appellants' Specification, page 2, lines 1-2. Further, Appellants' specification discusses that it would be advantageous to provide a system and method for enabling a user to specify by example the style of an output document, particularly specifying by example the nonfunctional aspects, including the text element position, annotations, alignment offsets, and document section order, to be applied to the functional aspects of an output document. Appellants' Specification, page 2, lines 3-6.

Claims 16-36 are clearly directed to formatting output documents in a style preferred by a user as well as enabling a user to specify by example the style of an output document. For example, as discussed above, claims 16 and 27 are directed to a computer program product embodied in a computer readable medium, which is not outside the four statutory categories, for generating an output document in a user preferred style. Further, claims 22 and 23 are directed to a computer program product embodied in a computer readable medium, which is not outside the four statutory categories, for generating an output document. Additionally, claim 24 is directed to a computer program product embodied in a computer readable medium, which is not outside the four statutory categories, for formatting a document. Furthermore, claim 26 is directed to a computer program product embodied in a computer readable medium, which is not outside the four statutory categories, for formatting documents. Additionally, claim 35 is directed to a computer program product embodied in a

computer readable medium, which is not outside the four statutory categories, for generating an output document with indentation of document components in a user preferred style. Hence, claims 16-36 do produce a useful, concrete and tangible result.

Thus, Appellants respectfully contend that claims 16-36 constitute statutory subject matter and request the Board to overturn the Examiner's rejections of claims 16-36 under 35 U.S.C. §101.

Further, as understood by Appellants, the Examiner, citing to page 28, lines 20-24 of Appellants' specification, asserts that the claimed "computer program product embodied in a computer readable medium" refers to a signal wave and therefore claims 16-36 are directed to non-statutory subject matter. Examiner's Answer, page 4. Appellants respectfully traverse the assertion that the language on page 28 of Appellants' specification indicates that claims 16-36 are directed to non-statutory subject matter.

There is no language on page 28 of Appellants' specification that causes claims 16-36 to be directed to non-statutory subject matter. Claims 16-36 are directed to a computer program product embodied in a computer readable medium. This is clearly directed to statutory subject matter. *See In re Beauregard*, 53 F.3d 1583 (Fed. Cir. 1995). As further evidence that claims directed to a computer program product embodied in a computer readable medium are directed to statutory subject matter, Appellants identified 334 patents issued by the United States Patents and Trademark Office that contain such language in at least one claim in their preamble.

B. Other matters raised by the Examiner.

All other matters raised by the Examiner have been adequately addressed above and in Appellants' Appeal Brief (July 8, 2005) and prior Reply Brief (May 24, 2007) and therefore will not be addressed herein for the sake of brevity.

II. CONCLUSION:

For the reasons stated above and in Appellants' Appeal Brief and prior Reply Brief, Appellants respectfully assert that the rejections of claims 1-13, 16-22, 24-36 and 40-43 are in error. Appellants respectfully request reversal of the rejections and allowance of claims 1-13, 16-36 and 40-43.

Respectfully submitted,

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